<u>REMARKS</u>

Claims 1-23 are pending in the application. Claim 20 is currently amended to correct a typographical error. No new matter has been added.

The Examiner rejected claims 1, 3-8, 10-20 and 22 under 35 U.S.C. 103(a) as obvious over U.S. Patent Publication No. 2004/0264397 by Benveniste in view of U.S. Patent Publication No. 2004/0103282 by Meier. The Examiner rejected claims 2, 9, 21 and 23 under 35 U.S.C. 103(a) as obvious over Benveniste and Meier in view of U.S. Patent Publication No. 2003/0126244 A1 by Smith et al. The Examiner's rejections are respectfully traversed. As an initial matter, it is not conceded that the references qualify as prior art and the right to swear behind the references is respectfully reserved.

To establish a *prima facie* case of obviousness when combining references, MPEP § 2143(A)(1) states the following (emphasis ours): "Office personnel <u>must articulate</u> the following: (1) <u>a finding that the prior art included each element claimed</u>, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference." MPEP § 706.02(j) further states (emphasis ours): "To support the conclusion that the claimed invention is directed to obvious subject matter, either <u>the references must expressly or impliedly suggest the claimed invention</u> or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)." *See also In re Thrift and Hemphill*, 298 F.3d 1357, 1366 (Fed. Cir. 2002) (for an examiner to establish a *prima facie* case that an invention, as defined by a claim at issue, is obvious the examiner must: (1) show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or the combined references) must teach or suggest all the claim limitations); MPEP § 2142. Moreover, a reference must be viewed as a whole, including portions that would lead away from the claimed invention. MPEP § 2141.02 (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). If the

proposed modification would change the principles of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP § 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959)).

Turning to the language of the claims, independent claim 1 recites, "[a] method to determine in a network component when to provide service to client devices operating in power-saving mode in a wireless network, said method comprising: receiving requests for service ... including a scheduled request received from a first one of the client devices and an unscheduled request received from a second one of the client devices, said network component being informed of said scheduled request by a field of a traffic specification format being set to a first value, said network component being informed of said unscheduled request by said field of said traffic specification format being set to a second value different from said first value." Independent claim 8 similarly recites, "said device being informed of said scheduled request by a field of a traffic specification format being set to a first value, said device being informed of said unscheduled request by said field of said traffic specification format being set to a second value different from said first value." Independent claim 18 similarly recites, "said network component being informed of said scheduled request by a field of a traffic specification format being set to a first value, said network component being informed of said unscheduled request by said field of said traffic specification format being set to a second value different from said first value." Independent claim 22 similarly recites, "become informed of the scheduled request based on a field of a traffic specification format being set to a first value; become informed of the unscheduled request by said field of said traffic specification format being set to a second value different from said first value."

The Examiner concedes "said network component being informed of said scheduled request by a field of a traffic specification format being set to a first value, said network component being informed of said unscheduled request by said field of said traffic specification format being set to a second value different from said first value," is not disclosed by Benveniste, and appears to concede this is not disclosed by Meier either.

The Examiner relies on the table appearing in Meier below paragraph 470, which is a table for a Subnet Context Manager Advertisement Reply Message, and to Unscheduled Flag

Bit 14, which is set ON in unscheduled advertisement messages. The Examiner contends Bit 14 is an unscheduled flag to indicate if the advertisement message is scheduled or unscheduled, and appears to contend this would have motivated the further modification to the combination of Benveniste and Meier to include such a field in a client request.

The Subnet Context Manager of Meier periodically transmits advertisement reply messages and access points (APs) discover the active SCM for a subnet by monitoring the advertisements. See Meier paragraph 387. It appears the unscheduled flag of Meier is set in an advertisement reply message when the message is in response to a node request for an advertisement message earlier than scheduled. The node sends such a request to shorten the discovery period for the active SCM. See Meier paragraph 388. Thus, the unscheduled field of Meier appears to indicate whether the advertisement is a periodic advertisement or a requested advertisement. This is not the same thing as a field of a traffic specification format which indicates whether a received <u>client request</u> is scheduled request or an unscheduled request, and thus the combination of Benveniste with Meier would not alone achieve the claimed invention. Smith does not cure the deficiencies of Benveniste. Thus, Benveniste, alone or in combination with Meier and Smith, does not teach, suggest, motivate or otherwise render obvious a field of a traffic specification format which indicates whether a client request is a scheduled request or an unscheduled request.

In the Final Office Action, the Examiner responds to the above arguments by emphasizing a difference between the combination of Benveniste and Meier and the claimed invention. Specifically, the Examiner emphasizes that Bit 14 of the advertisement message (a beacon) of Meier on which the Examiner relies indicates whether an advertisement message is a scheduled advertisement message or in reply to a request for an advertisement message. A field in an advertisement message transmitted by a client manager which indicates whether the advertisement message is a scheduled advertisement or a reply to a request from a node is not the same thing as a field of a traffic specification format indicating whether a client request is a request for scheduled service or a request for unscheduled service. An advertisement message from an SCM of Meier is not a request for service and is not from a client. In other words, the

Examiner has not shown that *all* of the elements of the claims are present in the combined reference.

Thus, to show obviousness, the Examiner must present a convincing line of reasoning as to why one of skill in the art would have further modified the combination of Benveniste and Meier. This the Examiner has failed to do. Instead the Examiner employs impermissible hindsight reasoning: "[m]otivation to combine these references comes from an access point being able to differentiate between scheduled and unscheduled requests to provide increased QoS for scheduled requests since they are arranged in advance." This reasoning also appears to be contrary to the principles of operation of Meier. A request for an unscheduled advertisement is issued by a node of Meier to speed up the discovery process. If such requests are not honored before the next scheduled advertisement message from an SCM, the process of discovery would not be sped up. The Examiner also appears to contend that Benveniste already knows whether a client request is for scheduled or unscheduled service when it is received. Assuming the Examiner's interpretation of Benveniste is correct, there would be no motivation to modify Benveniste to include such a field in client requests.

Claims 2-7 depend from claim 1. Claims 9-17 depend from claim 8, claims 19-21 depend from claim 18 and claim 23 depends from claim 22. Accordingly, claims 1-23 are not rendered obvious by Benveniste alone or in combination with Meier and Smith.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC

___/Timothy L. Boller/_____
Timothy L. Boller
Registration No. 47,435

TLB:jrb

701 Fifth Avenue, Suite 5400
Seattle, Washington 98104
Phone: (206) 622-4900
Fax: (206) 682-6031

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